## REMARKS

Claims 1-20 were pending in the present application, all of which stand rejected. This response amends Claims 1, 3-5, 7, 8, 11, 13-15, and 17, and cancels Claim 6. Accordingly, Claims 1-5 and 7-20 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

### Rejections under 35 USC § 103

Claims 1-20 are rejected under 35 USC § 103(a) as allegedly being unpatentable over Vancura (US 6,998,732).

In order to show a *prima facie* case of obviousness, each and every feature of the claims must be taught or suggested by the cited references. See MPEP § 2143.03. Vancura fails to disclose a gaming machine "having a display and a game controller arranged to control images of symbols displayed on the display, the game controller being arranged once a player has bet a wager to play a base game wherein at least one random event is caused to be displayed on the display and, if a predefined winning event occurs, the machine awards a prize, the game controller being adapted to test whether a trigger event has occurred during the play of a base game, and if so, award the player a game feature, the game feature having a plurality of possible outcomes with each outcome having a different probability of occurring ..." as recited in Claim 1, as amended. (Emphasis added).

Rather than disclose a game feature having a plurality of possible outcomes of different probability (i.e., a game of chance), Vancura describes a "knowledge based casino game" suitable for use as a bonus game to a conventional casino game of chance. Although several embodiments of Vancura's knowledge based game are described, the general principle appears to be that a player is presented with a question or puzzle to which there is a knowable and "right" answer. Such "knowledge based" games are explicitly defined by Vancura to yield a result "without any element of chance." (Col. 3, lines 37-44). This is in contrast to "chance" type games in which an outcome is

not definitively knowable but instead has some probability of occurrence. In particular, the knowledge based games disclosed in Vancura do not have a "a plurality of possible outcomes with each outcome having a different probability of occurring."

A *prima facie* case of obviousness also requires "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP § 2143. Changing the knowledge based bonus game of Vancura – a game in which a "right" answer by definition exists (whether that answer is known to the player or not) – to a game in which there is no possibility of a player knowing the correct answer is a fundamental shift in thinking. Neither the Office nor Vancura provide any motivation for such a fundamental alteration of the game disclosed by Vancura.

Vancura also fails to disclose a gaming machine "further comprising a selector operable by the player prior to the play of the awarded game feature to enable a player to select at least one of the possible outcomes of the game feature and, if the selected outcome occurs the game controller is adapted to award a bonus to the player ...." as recited in Claim 1, as amended. (Emphasis added). The Office alleges that "Vancura discloses allowing the player to make a prediction that constitutes one of a number of possible outcomes of game features (i.e. The Price Is Right game, Family Feud game, Trivial Pursuit game, Proximate Responses, or Puzzles games, etc.)." (Office Action, page 3). Applicants disagree.

In particular, Applicants respectfully suggest that the Office may be confusing selecting a possible outcome of a game feature, as in the present Claim 1, with play of the game feature. In Vancura's The Price Is Right bonus game, for example, the player is shown an object and three prices, and has several opportunities to guess the correct price to win a bonus payout. (Col. 10 lines 1-13, col. 11 lines 4-13). One of ordinary skill in the art would understand that these guesses occur during the play of the bonus game, and thus are not predictions of the outcome of the bonus game as the Office apparently suggests. Moreover, since these guesses occur during play of the bonus game they do not occur "prior to the play of the awarded game feature" as recited in Claim 1, as amended.

Vancura further fails to disclose a gaming machine "wherein the value of the bonus awarded to the player is related to the probability of achieving the selected outcome" as recited in Claim 1, as amended. As the Office notes on page 3 of the Office Action, Vancura discloses increasing a payoff as questions become more difficult (col. 15, lines 16-22). However, as explained above these questions occur during play of Vancura's game and are not instances of selecting an outcome as in Claim 1, as amended.

For at least the above reasons, Claim 1, as amended, is patentable over Vancura et al. Claims 2-10 are directly or indirectly dependent on Claim 1 and thus patentable over Vancura for at least that reason. Hence, Applicants respectfully request withdrawal of the rejection of Claims 1-10 under 35 USC § 103(a).

Independent method Claim 11, as amended, is patentable over Vancura for at least the reason that it recites the step of "prior to the play of the game feature, allowing the player to select, using the selector, one of a plurality of possible outcomes to occur during the play of the feature game ...." (emphasis added). As explained above, at least this step is not disclosed in Vancura.

Claims 12-20 are directly or indirectly dependent on Claim 11 and thus patentable over Vancura for at least that reason. Hence, Applicants respectfully request withdrawal of the rejection of Claims 11-20 under 35 USC § 103(a).

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## CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to ***Deposit Account No. 03-1952*** referencing docket no. 595122001600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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